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| 09/510,378      | 02/22/2000  | Maurcen T. Cronin    | 18547-004131US      | 3064             |

33494 7590 12/21/2004

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EXAMINER

MARSCHER, ARDIN H

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1631

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/510,378

Applicant(s)

CRONIN ET AL.

Examiner

Ardin Marschel

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 07 September 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached explanation.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of reasons of record as further discussed as attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 88 and 89.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 82-87 and 90-94.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Further explanation of item # 2 on the enclosed Advisory action:

The proposed amendment, filed 9/7/04, raises the new issues of NEW MATTER as well as raising new issues requiring further consideration and/or search. Firstly, NEW MATTER has been raised by requiring as proposed in lines 10-11 and 17 of claim 82 and line 16 of claim 85 and lines 11 and 18 of claim 90 the "collectively" characterizations of probes regarding being "exactly complementary to each base" of the reference sequence and "collectively" having at least three interrogation positions. These characterizations as being required to be "collectively" present have neither been found as filed regarding written basis nor pointed to by applicants as to supporting written disclosure as filed and therefore are NEW MATTER.

These characteristics of probes as being "collectively" characterized, as summarized above, are also new issues that would require further consideration and/or search regarding methodology that utilizes such probes as instantly claimed.

Further explanation of item # 5 on the enclosed Advisory action:

The rejection of claims 82-87 and 90-94 based on vagueness and indefiniteness is maintained and reiterated from the previous office action, mailed 6/2/04. Applicants argue firstly that the limitation "spanning" in the context of claim 82 wherein different probes are exactly complementary to a reference sequence refers to overlapping probes whose aggregate length is the same as that of the reference sequence. In response, applicants' argument is inconsistent with the actual claim wording wherein the probes are cited in part (a)(1) of claim 82 as being exactly complementary to a "subsequence of the reference sequence". Applicants' argument ignores the subsequence limitation. Thus, the spanning limitation is not directed to spanning exactly the reference sequence but rather is confused as to whether the spanning of the

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reference sequence is exact or combined unclearly with the above noted subsequence limitation regarding probes cited in said part (a)(1) of claim 82. Applicants then argue that, in the interest of compromise, they have amended by replacing "spanning" with analogous terminology regarding "exactly complementary". This is not persuasive, even it had been entered. The proposed amending regarding replacing "spanning" with an "exactly complementary" limitation directed to each base of the reference sequence would conflict with the metes and bounds of the "exactly complementary" to a subsequence limitation in the first two lines of claim 82, part (a)(1) thus leaving the replaced spanning wording still vague and indefinite as to which of these limitations would control the metes and bounds of the claim. This vagueness and indefiniteness would also have remained in claim 90, even if the amendment had been entered, and claims dependent therefrom due to their dependence.

Applicants further argue that the "collectively" limitation such as set forth in line 17 and correspondingly in claims 85 and 90 clarifies the issue of three vs. one interrogation positions limitations in respective parts of said claims. In response, the amendment proposed as filed 9/7/04 has not been entered for reasons given above which causes this issue to remain. If the amendment had been entered, this issue of vagueness and indefiniteness would have been overcome.

Claims 88 and 89 are allowable.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is

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(571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 17, 2004

*Ardin H. Marschel* 12/17/04  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER